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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,975	12/08/2003	Shu-Ming Lin	LIUS3007/EM	1101

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EXAMINER	
HOANG, DANIEL L	
ART UNIT	**PAPER NUMBER**
2136	

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12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,975	LIN, SHU-MING	
	Examiner	Art Unit	
	Daniel L. Hoang	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments, see page 8, filed 9/13/07, with respect to the rejection(s) of claim(s) 1 and 8 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cargile, US Patent No. 4609777.

It is noted that the current amendment of claims 1 and 8, which are intended by applicant to recite the original subject matter of dependent claim 6, have not been amended in a manner that includes all of the original limitations of the claim. Specifically, the limitation "thereby enabling the user to view the status of the document" is not included in the current claim. Examiner also suggests that the subject matter of current claim 5 may need to be included in the current independent claims because it seems that the verification procedure of claim 5 is a prerequisite to the limitations of the prior claim 6 which have been added to the current claim 1. Depending on applicant's intent, claim 1 may or may not be missing certain steps.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandys, US Patent No. 7,188,362, and further in view of Thomas, US PGP No. 20040015699 and Cargile, US Patent No. 4,609,777.

As per claim 1, 8:

A method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system, whereby the first electronic key comprises a memory, which is utilized to store a random number, and the computer system comprises a storage device and an add-in program; the method includes steps of:

(a) inserting the first electronic key into the computer system, then utilizing the add-in program to define the electronic seal and generate a corresponding random number, and storing the random number into the storage device and the memory;

(b) utilizing the add-in program to insert the electronic seal into the contents of the document and generate attributes of the document, and inserting the attributes of the document into the contents of the document; and

(c) after implementing step (b) and removing the first electronic key from the computer system, once again inserting the first electronic key into the computer system, said first electronic key opening the document and enabling the user to view said attributes.

The Brandys reference teaches a portable device that digitally signs a message (see col. 2, lines 21-31). Said portable device is capable of generating and storing random numbers. Examiner is interpreting the claimed invention's "electronic seal" as not being analogous to a digital signature. If this interpretation is inaccurate, examiner respectfully requests notification from applicant. Based on this interpretation, Brandys is mute in teaching the insertion of an electronic seal into the contents of the document.

The Thomas reference teaches the aforementioned deficiencies in the Brandys reference. Thomas teaches a system capable of inserting an electronic identification seal into a document (see para. 0061).

It would have been obvious, at the time of the invention, to one of ordinary skill in the art to which the subject matter pertains to implement the system taught by Thomas within the portable device taught by Brandys in order to incorporate the portability provided by the Brandys reference with the security provided by the Thomas reference.

Neither the Thomas reference nor the Brandys reference teach that the removing the key and re-inserting it in order to gain access to the document. Cargile teaches the above limitation not present in the Thomas and Brandys references, see col. 2, lines 60-68. It would have been obvious at the time of the invention to implement that which is taught by Cargile in order to thwart unauthorized usage or copying of the document, see col. 2, lines 36-44.

As per claim 2, 14:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the random number is generated according to characteristics of the electronic seal and a scrambled number.

[see Brandys, col. 8, lines 45-57]

As per claim 3, 15:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the electronic seal is amended in accordance with the random number, and thereby stored in the storage device, and the electronic seal inserted into the contents of the document is provided with an image generated by the random number.

[see Thomas, para. 0063]

As per claim 4, 16:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein prior to implementing step (a), in accordance with identity and password entered by a user, the computer system implements identity validation procedures in order to prevent misappropriation of the first electronic key.

[see Brandys, fig. 2, elements 216 and 200]

As per claim 5, 17:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein after implementing step (b), the first electronic key is once again inserted into the computer system, and a verification procedure is implemented to verify whether or not the random number stored within the storage device is consistent with the random number stored within the memory.

[see Brandys, col. 3, lines 66-67 and col. 4, lines 1-10]

As per claim 7, 18:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein after implementing step (b) the document can be locked thereby preventing modification of the contents of the document.

[see Brandys, fig. 3, element 208, wherein examiner interprets encrypting the message as being analogous to locking the document.]

As per claim 9, 19:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the first electronic key is provided with a key, and upon touching the key the electronic seal is inserted into the contents of the document.

[see Brandys, col. 6, lines 35-43]

As per claim 10, 20:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the electronic seal can be inserted into the contents of the document through a user interface of the computer system.

[see Thomas, para. 0072]

As per claim 11, 21:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the memory is electrically erasable programmable read only memory (EEPROM).

[see Brandys, col. 3, lines 1-14]

As per claims 12, 13, 22, 23:

The method of using a first electronic key for inserting an electronic seal into contents of a document in a computer system according to claim 1, wherein the first electronic key is connected to the computer system through a Universal Serial Bus port/ RS-232 port.

Brandys invention teaches of a portable device but does not specifically mention that the device is connected to the computer system through either a USB port or a RS-232 port. Both said ports are well known in the art to interconnect devices. It would have been obvious at the time of the invention, to one of ordinary skill in the art to which the subject matter pertains to connect the portable device to the computer system through either a USB port or a RS-232 port or any other peripheral interfaces. Examiner further argues that this is merely a matter of design choice.

POINTS OF CONTACT

*. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

*. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Hoang
12/10/07

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12/10/07